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JUN 23 2006

OFFICE OF PETITIONS

In re Application	:	
Koster, et al.	:	
Application No. 09/067,337	:	DECISION ON APPLICATION
Filed: April 27, 1998	:	FOR PATENT TERM ADJUSTMENT
Atty Docket No. 17111-002001	:	

This is a decision on the "PETITION FOR PATENT TERM ADJUSTMENT PURSUANT TO 37 CFR §1.705(b)", filed May 8, 2006. Applicants request that the initial determination of patent term adjustment under 35 U.S.C. 154(b) be corrected from zero (0) days to five hundred thirty-two (532) days.

The application for patent term adjustment is GRANTED to the extent indicated herein.

The Office has updated the PAIR screen to reflect that the correct Patent Term Adjustment (PTA) determination at the time of the mailing of the Notice of Allowance is **five hundred thirty (530) days**. A copy of the updated PAIR screen, showing the correct determination, is enclosed.

As a Continued Prosecution Application (CPA) was filed in the instant application on March 12, 2001, the application is entitled to the benefits of the patent term adjustment provisions of 35 U.S.C. §154(b) and 37 C.F.R. §§1.702 through 1.705.¹

¹ See MPEP 2730.

On February 8, 2006, the Office mailed the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above identified application. The Notice stated that the patent term adjustment (PTA) to date is zero (0) days.

On May 8, 2006, Applicants timely² submitted the instant application for patent term adjustment, asserting that the correct number of days of PTA at the time of the mailing of the Notice of Allowance is one thousand, one hundred sixty-seven (1167) days.

Applicants assert entitlement to a patent term adjustment of five hundred thirty-two (532) days on the basis that the PTO improperly mailed a Restriction Requirement on November 9, 2004. According to applicants, PTO delay should have been assessed using the date that the Office mailed the following Office action, a final rejection, on June 6, 2005, for a period of five hundred sixty-nine (569) days of PTO delay. Moreover, Applicants assert that the ninety (90) days of Applicant delay for responding to the Restriction Requirement on May 10, 2005 was improper. Finally, Applicants point out that they should not have been assessed Applicant delay of three hundred sixty-six (366) days pursuant to 37 C.F.R. §1.704(c)(8) for filing an IDS on July 17, 2004. According to Applicants, the IDS was filed on the same day as the response, on July 17, 2003.

Applicants state that the patent issuing from the application is not subject to a terminal disclaimer.

The Office initially determined a patent term adjustment of zero (0) days based on an adjustment for PTO delay of thirty-eight (38), fifteen, and three hundred fifty-eight (358) days pursuant to 35 U.S.C. 154(b)(1)(A)(ii) and 37 C.F.R. §1.703(a)(2), reduced by Applicants' delays of three hundred sixty-six (366) days pursuant to 35 U.S.C. 154(b)(2)(C)(i) and 37 C.F.R. §1.704(c)(8) and ninety (90) days pursuant to 35 U.S.C. 154(b)(2)(C)(ii) and 37 C.F.R. §1.704(b). The adjustments of three hundred fifty eight (358), three hundred sixty-six (366) and ninety (90) days are at issue.

With respect to the three hundred sixty-six (366) days of Applicant delay pursuant to 37 C.F.R. §1.704(c)(8), such delay has been found to be in error. A review of the application file

² Applicants filed the application for patent term adjustment together with the payment of the issue fee.

reveals that Applicants did not file an IDS on July 17, 2004, but rather on July 17, 2003. Accordingly, Applicant delay with respect to this filing should have been zero (0) days.

With respect to the three hundred fifty-eight (358) days of PTO delay, the Office was assessed this delay for mailing a Restriction Requirement on November 9, 2004. Applicants were in turn assessed Applicant delay of ninety (90) days for filing a response on May 10, 2005. However, in an Interview Summary mailed on May 19, 2005, the Examiner indicated that the Restriction Requirement was mailed in error, would be vacated, and replaced with an Office action in response to Applicants' July 17, 2003 Amendment. Accordingly, it is concluded that Applicants should not have been assessed ninety (90) days of delay in responding the Restriction Requirement. Moreover, it is concluded that PTO delay in responding to Applicants' July 17, 2003 Amendment should have been assessed using the date the next Office action was mailed, a final rejection on June 6, 2005. In view thereof, PTO delay of five hundred sixty-seven (567) days should have been assessed, not five hundred sixty-nine (569) days as asserted by Applicants.

In view thereof, the correct determination of patent term adjustment at the time of the mailing of the Notice of Allowance is **five hundred thirty (530) days** (621 (39+15+567) days of PTO delay, reduced by 91 days of applicant delay).

Receipt of the \$200.00 fee set forth in 37 C.F.R. §1.18(e) is acknowledged.

The application is being forwarded to the Office of Patent Publications for processing into a patent.

Telephone inquiries specific to this matter should be directed to Cliff Congo, Petitions Attorney, at (571)272-3207.

Kery Fries
Senior Legal Advisor
Office of Patent Legal Administration
Office of Deputy Commissioner
for Patent Examination Policy

Enclosure: Copy of Revised PAIR Screen



MAY 10 2006

Attorney's Docket No.: 17111-002001 / 2301

Mac

THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Hubert Köster et al. Art Unit : 1623
Serial No. : 09/067,337 Examiner : Paul V. Ward
Filed : April 27, 1998
Title : SOLUTION PHASE BIOPOLYMER SYNTHESIS

MAIL STOP: PETITIONS / OPLA

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PETITION FOR PATENT TERM ADJUSTMENT PURSUANT TO 37 CFR §1.705(b)

Applicant hereby petitions for reconsideration of the Patent Term Adjustment (PTA) accorded the above-referenced patent at time of allowance. The *Notice of Allowance* and *Determination of Patent Term Adjustment* under 35 U.S.C. 154(b), mailed February 8, 2006, states that the Total Patent Term Adjustment at Allowance is "0" days. Reconsideration of the PTA to reasonably increase USPTO Delay from 412 days to 623 days, decrease APPL Delay from 547 days to 91 days, and increase Total PTA from "0" days to 532 days, is respectfully requested.

The Issue Fee Transmittal along with fee payment for the above-referenced application is also being filed this date under separate cover to Mail Stop Issue Fee.

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CERTIFICATE OF MAILING BY "EXPRESS MAIL"
"Express Mail" Mailing Label Number EV 471535203
Date of Deposit: May 8, 2006
I hereby certify that this paper is being deposited with the United States Postal "Express Mail Post Office to Addressee" Service under 37 CFR §1.10 on the date indicated above and is addressed to: Commissioner for Patents, U.S. Patent and Trademark Office, P.O. Box 1450, Alexandria, VA, 22313-1450.

Judy Sherman
Judy Sherman

The Patent Term Adjustment History in the PAIR system reflects that the U.S. Patent and Trademark Office (PTO) calculated the PTA as follows:

(1) PTO mailing of an *Office Action/Restriction Requirement* in response to *Election Response* filed August 8, 2001, due on the four-month date of December 8, 2001, and actually mailed on January 16, 2002. Applicant is in agreement with the PTO Delay of 39 days;

(2) PTO mailing of an *Office Action/Non-Final Rejection* in response to *Election/Response* filed March 1, 2002, due on the four-month date of July 1, 2002, and actually mailed on July 16, 2002. Applicant is in agreement with the PTO Delay of 15 days;

(3) APPL *Response after Non-Final Action* which included an *Information Disclosure Statement*, due at a three-month date of July 21, 2003 and timely received by the PTO on July 17, 2003. The *Information Disclosure Statement* was incorrectly entered as being received on July 17, 2004, according an APPL Delay of 366 days. Applicant is not in agreement with the calculated APPL Delay of 366 days and contend there should be no APPL delay days as made evident in the comments below;

(4) PTO mailing of a *Office Action (Restriction Requirement)*, due at a four-month date of November 17, 2003, and actually mailed on November 9, 2004; Applicant acknowledges the accuracy of the accorded PTO Delay of 358 days given the respective dates entered in the file history, however, the *Restriction Requirement* was mailed in error by the new Examiner recently assigned to the application in an attempt to exam and prosecute the application with incomplete (lost or missing) papers. As the **File History** entries do not indicate the actual events that transpired, Applicant contends the omissions created a further PTO Delay of 211 days for a total of 569 days for the Office's failure to respond with a proper office action within four months of Applicant's *Response* timely received July 17, 2003;

(5) APPL *Response to Election / Restriction Filed*, which would appear to have a three-month due date of February 9, 2005, and actually received by the PTO on May 10, 2005 according to the present File History; however, this is not an accurate accounting of the prosecution events. Applicant is not in agreement with the APPL Delay of 90 days, and contend there should be no APPL delay days as made evident in comments below; and

with two documented telephonic *Examiner Interview Summaries* with Examiner Ward which were mailed May 19, 2005. One *Interview Summary* was with Ms. Judy Sherman for a telephone interview on May 6, 2005 stating the *Office Action (Restriction)* dated November 9, 2004 would be vacated and no Applicant response was required as there was nothing outstanding; and the second *Interview Summary*, with the undersigned, Dr. Stephanie Seidman, was for a telephone interview on May 10, 2005 and requested a change in a term in the claims to which Applicant agreed and immediately faxed such agreement and amendment directly to Examiner Ward for consideration that date. A copy of each Interview summary is attached for your convenience.

As demonstrated, the November 9, 2004 *Office Action/Restriction* was vacated and no response was outstanding, therefore, the May 10, 2005 entry for a *Response to Election /Restriction Filed* and the APPL Delay of 90 days is an error as referenced in comment (5) above. Applicant respectfully requests that the 90 days be removed and adjusted to 0 days.

In conclusion for this series of events, the valid and true PTO action following the Applicant's July 17, 2003 *Response* was a *Final Rejection* mailed June 6, 2005. The Office failed to respond within four months and as such this correct response from the PTO constitutes the actual PTO delay of prosecution by 569 days. Applicant respectfully requests the additional adjustment of 211 PTO Delay Days to the existing 358 PTO Delay Days accorded November 9, 2004, for a total of 569 PTO Delay Days for the mailing of a proper *Office Action/Response*.

In summation and in consideration of the foregoing clarification regarding errors and omission as they relate to the July 17, 2003 *Response* and subsequent PTO lengthy delay in responding, Applicant respectfully submits and requests that the current determination of the Patent Term Adjustment at Allowance be re-calculated as follows:

- PTO Delay adjustment from 412 days to 623 days
- APPL Delay adjusted from 547 to 91 days
- Total PTA be adjusted from "0" days to 532 days

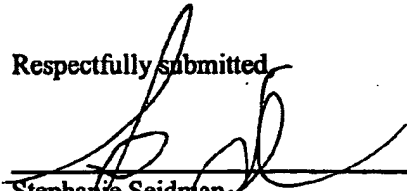
Copies of the following documents are provided in order of reference:

- (1) *Petition for Patent Term Adjustment Pursuant to 37 CFR 1.705(b)*, and *PTA Petition Decision* for related application 09/484,484, reconsidered by Mr. Fries;
- (2) *Transmittal Letter* listing the *Information Disclosure Statement*, page 1 of *Amendment and Response* of July 17, 2003, Express Mail label, and date-stamped postcard.
- (3) *Interview Summary* with Ms. Sherman, May 6, 2005, and *Interview Summary* with Dr. Seidman, May 10, 2005; both mailed May 19, 2005.

Enclosed is a check for \$200.00 in payment of the petition fee required by 1.18(e).
Please apply any other charges or credits to Deposit Account No. 06-1050.

Thank you for your consideration of this Petition. If there should be any questions or additional information required, please call the undersigned.

Respectfully submitted



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(6) APPL *Response and Request for Continued Examination (RCE)*, due on a three-month date of September 9, 2005, and actually received by the PTO on December 6, 2005. Applicant is in agreement with the APPL Delay of 91 days.

REMARKS

For consideration of this *Petition* and as a courtesy to the Office, the Applicant has respectfully attached a copy of the *Petition for Patent Term Adjustment Pursuant to 37 CFR 1.705(b)* and the *PTA Petition Decision* for the continuation application US Serial No. 09/484,484 (of the instant application) which was also a problematic application and experienced similar tribulations during pre-allowance prosecution due to incomplete files, as these cases remained traditional paper files for some time, and prosecution by at least three different examiners.

As stated in comment (3) above, a *Response and Information Disclosure Statement* were received by the PTO on the same day, July 17, 2003, as evidenced by the attached copy of the Express Mail label, PTO date-stamped return post card, and the Transmittal Letter with a signed Certificate of Mailing. Applicant did not submit an Information Disclosure Statement on July 17, 2004. It appears the error was simply clerical in nature which resulted in a (leap) year or 366 days of APPL Delay. Applicant respectfully requests the 366 days be removed and adjusted to 0 days.

With reference to comment (4) above, and as experienced in the related application, the *Restriction Requirement* was issued erroneously. It was to be based on the original claims and not the pending claims, further evidencing that the PTO file was incomplete at that time after being inactive and set aside upon the departure of the second Examiner Josephine Young. Ms. Young was briefly assigned to the case towards the end of 2002. After Applicant's receipt of the *Restriction Requirement* and during telephonic exchanges with Examiner Ward, it was agreed that the Requirement was erroneously issued and would be withdrawn. A *Notice of Withdrawn Action*, however, was never properly entered or mailed. Again, as with the related application, there is no evidence of this document in the PTO files/IFW. Diligent and a more than reasonable amount of telephone inquiries, discussions, and electronic correspondence with Examiner Ward and his Supervisor, James Wilson, ensued for months requesting a written withdrawal and new action, eventually concluding